

In re Patent Application of
MARIAUD ET AL.
Serial No. 09/990,629
Filed: NOVEMBER 16, 2001

REMARKS

Applicants thank the Examiner for the careful and thorough examination of the present application, and for the indication of allowable subject matter. Claims 7-26 remain pending in the application. Favorable reconsideration is respectfully requested.

I. The Invention

As shown in FIGS. 6-8, for example, the disclosed invention is directed to automatic monitoring of the input terminal VBUS while avoiding the regular and frequent intervention of the microcontroller program. The device of the invention automatically controls a voltage Vcc applied to one of two data conductors of a USB type serial link cable in a peripheral apparatus connected upstream to another apparatus.

II. The Claims are Patentable

The Examiner has rejected claims over newly cited prior art references, Rothenbaum (U.S. Patent No. 6,128,743) in view of Lee (U.S. Patent No. 6,516,418) for the reasons set forth on pages 2-4 of the Office Action. The Examiner has indicated the allowability of the subject matter of Claims 8, 14, 19 and 23. Applicants contend that Claims 7-26 clearly define over the cited references, and in view of the following remarks, favorable reconsideration of the rejection under 35 U.S.C. §103 is requested.

The Rothenbaum patent is directed to a bus hub for connection via a serial bus to a serial bus host hub which includes a connector to a power supply, a bus controller and a

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switch coupled to the bus controller and to the power supply. The switch switches the bus hub between being powered by the power supply and being powered by the power from the serial bus host hub by switching the mode of operation between self-powered mode and bus-powered mode. As correctly recognized by the Examiner, the bus hub does not include a memory associated with the detection circuit and storing a logic value indicating the presence or absence of the second voltage received on the second wire of the USB.

In short, the Rothenbaum reference teaches the use of a switching a USB-hub between two kinds of power supplies. The reference does not deal with the protection of a peripheral device. Thus, the power switching in Rothenbaum is different than in the claimed invention.

The Lee patent relates to a portable computer system with universal serial bus port or ports and a method for controlling power of the universal serial bus port. The Examiner correctly pointed out that the system of Lee includes a memory which stores an enabled state or disable state of the USB port. However, as in the Rothenbaum reference, there is no teaching of a memory associated with a detection circuit for storing a logic value indicating the presence or absence of a second voltage received on a second wire of the USB.

Indeed, Lee is directed to a technical field quite different from Rothenbaum and/or the present invention. Lee discloses a circuit that selectively switches off power supply on the USB port in a laptop computer. Lee switches off the USB port power supply when an overcurrent is sensed (for protection) or when the laptop is powered through its battery (for power saving). Lee does not discuss anything related to

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the behavior of the USB port when a peripheral USB device is connected to it. Accordingly, Lee is not concerned with the protection of a peripheral USB device against accidental powering of the data lines, as in the present invention. The memory in Lee is used to define whether the USB port is activated or not, independently from the state of any peripheral device.

Thus, even if the hypothetical combination of teachings asserted by the Examiner were obvious to the skilled artisan, the combination still does not meet the features of the claimed invention.

Secondly, Applicants maintain that the Examiner is impermissibly using the teachings of Applicants' own patent application as a roadmap to modify the prior art. For example, as noted above, the Lee reference is not concerned with the protection of a peripheral USB device against accidental powering of the data lines. Again, there is no disclosure or teaching of a memory associated with a detection circuit for storing a logic value indicating the presence or absence of a second voltage received on a second wire of the USB.

As the Examiner is aware, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim features. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the Applicants have done. To support the conclusion that the

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claimed invention is directed to obvious subject matter, either the reference must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference. Both the suggestion to make the claimed combination and the reasonable expectation of success must be founded in the prior art and not in Applicants' disclosure.

There is simply no teaching or suggestion in the cited references to provide the combination of features as claimed. Accordingly, for at least the reasons given above, Applicants maintain that the cited references do not disclose or fairly suggest the invention as set forth in Claims 7, 13, 18 and 22. Furthermore, no proper modification of the teachings of these references could result in the invention as claimed. Thus, the rejection under 35 U.S.C. §103(a) should be withdrawn.

It is submitted that the independent claims are patentable over the prior art. In view of the patentability of the independent claims, it is submitted that their dependent claims, which recite yet further distinguishing features are also patentable over the cited references for at least the reasons set forth above. Accordingly, these dependent claims require no further discussion herein.

III. Conclusion

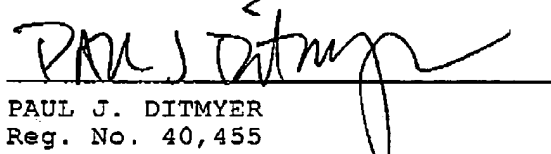
In view of the foregoing remarks, it is respectfully submitted that the present application is in condition for allowance. An early notice thereof is earnestly solicited.

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If, after reviewing this Response, there are any remaining informalities which need to be resolved before the application can be passed to issue, the Examiner is invited and respectfully requested to contact the undersigned by telephone to resolve such informalities.

Respectfully submitted,


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CERTIFICATE OF FACSIMILE TRANSMISSION

I HEREBY CERTIFY that the foregoing correspondence has been forwarded via facsimile number 703-872-9306 to MAIL STOP AMENDMENT, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450, on this 12th day of January, 2005.

